



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,131	01/05/2000	Joseph Nardoza	MAT-2C2B	1285

7590 08/01/2006

KOLISCH HARTWELL DICKINSON
MCCORMACK & HEUSER
200 PACIFIC BUILDING
520 SOUTH WEST YAMHILL STREET
PORTLAND, OR 97204

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/478,131	Applicant(s) NARDOZZA ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In view of the Response filed 19 June 2006, the following is placed in effect.

The rejection of claims 1-9, 11-19 and 21-25 under 35 U.S.C. 103(a) as being unpatentable over Cordova (US 5,990,205) or Bowles (US 5,333,405), taken with Levy (US 5,698,210), or Young, Sr. et al (US 5,432,000), and in further view of Gebhard et al (US 5,612,397) and Hughes et al (US 4,859,242), is hereby expressly withdrawn.

The following grounds of rejection are being made.

Claim Interpretations

The combination of the several ingredients of the formulation, due to the number of required constituents, necessarily would not be found within the confines of a single reference. Only the superabsorbant polymer, the binder, colorant, metal glitter and preservative are disclosed and recited as having particular functions. No specific function is disclosed for either the gum or gelatin other than that the gum provides a "cohesiveness to the composition," and that the gelatin is "fluid-swellable." Since these constituents provide art-recognized functions to compositions embracing the composites of the instant claims, the various constituents will be viewed in their known capacities.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

Art Unit: 1711

of the following is required: In claim 21, the recitation of "a water-based fluid" does not find enablement in the Specification.

The Specification is so vague at the paragraph bridging page 10 to page 11 as to "fluid" as to be almost without meaning. The Specification fails to elucidate what this "fluid" may be.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8, 14, 21, 22, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation in claim 8 of "selected to preserve the composition in a dry and a liquid state" fails to state what the preservative is in terms of composition, but rather, that it is "selected." The recitation would require the skilled artisan to perform the undue burden of experimentation to determine what may be embraced thereby since there is not provided guidance to determine.

The recitation of claim 14 of "the gum is selected to absorb glycols," likewise fails to state what the gum is in terms of composition, but only that it is "selected" to perform a certain feat, e.g. "absorb glycols." The recitation would require the skilled artisan to

Art Unit: 1711

perform the undue burden of experimentation to determine what may be embraced thereby since there is not provided guidance to determine. It is not clear to the Examiner why this criterion of “absorb glycols” is presented since there doesn’t appear to be glycols in the composition.

The recitation in claim 21 of “a color that is not readily perceivable to a user until a water-based fluid is added to the composition,” again would require the undue burden of experimentation to determine what is suitable since the claim is not drawn to any constituents, per se.

The recitation in claim 22 of “configured to move with other components” is not indicative as to what is being claimed. Again, the skilled artisan would be required to perform the undue burden of experimentation to determine what would be usable.

The recitation in claim 24 that the resin is “adapted to adhere the superabsorbant polymer and the gelatin” is not indicative or definitive of what is actually being claimed. Again, the skilled artisan would be required to perform the undue burden of experimentation to determine what would be usable.

The recitation of claim 25 of “is adapted to absorb” is not indicative or definitive of what is actually being claimed. Again, the skilled artisan would be required to perform the undue burden of experimentation to determine what would be usable.

None of the functional recitations of claims 21, 22, 24 and 25 serve to define the invention with the particularity required of 35 USC 112, first paragraph.

The many recitations of “water-based fluid” in claims 21, 22, 24 and 25 are not enabled by the Specification as to what is being claimed. The recitation is not

expounded in the Specification and would require the undue burden of experimentation to determine what may be employed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the components therein in functional terms that are not definitive as to what is being claimed, e.g. the metes and bounds of the claims. Since the claims do not recite any specific constituents, but define them in terms of their function, it cannot be clearly ascertained as to the proper metes and bounds of the claims. As such, the claims are deemed to be vague and confusing.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11-19 and 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,503,582. Although the conflicting claims are not identical, they are not patentably distinct from each other because the practice of the claims of the parent patent would necessarily require the composition, as recited. The patent discloses and teaches all parameters necessary to produce the invention now claimed, and as employed in the claims of the patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girg et al (US 5,432,215), Brüggemann et al (US 6,103,358), Suskind et al (US 5,549,590), all newly cited, and Young, Sr. et al (US 5,432,000), previously cited, taken in view of Cordova (US 5,990,205), Gebhard et al (US 5,612,397), Levy (US 5,698,210) and Bowles (US 5,333,405), all previously cited.

The instant claims are drawn to an absorbent composition that consists essentially of granular constituents of a superabsorbant polymer, a gum, gelatin, and a binder. The claims may include a colorant, reflective particles and a preservative, which are not recited to be in either granular form or even in dry form. The combination of

references teaches the constituents, as recited and claimed herein, for their art-recognized functions in compositions.

The reference to Girg et al (US 5,432,215) shows the production of "thickening agents" that comprise a superabsorbant polymer and guar gum at column 2 (lines 37-54). The reference shows these constituents to be in powder form at the Abstract, and including the binder at the paragraph bridging column 5 to column 6. The reference teaches admixing the constituents in powder form at column 5 (lines 19-29). The reference shows the use of preservatives. Note Tables 7 and 8.

The patent to Brüggemann et al (US 6,103,358) also teaches the production of absorbent compositions that may include a superabsorbant polymer, a gum, including guar, and pigments. Note column 4 (lines 15-32) and column 3 (lines 41 et seq.). The constituents are taught as being powder in form.

The reference to Suskind et al (US 5,549,590) shows the production of a particulate composition of a superabsorbent with gelatin and includes a colorant, as claimed. Note column 5 (lines 1-49).

The patent to Young, Sr. et al (US 5,432,000) teaches the manufacture of a particulate superabsorbant composition. Note the Abstract. The patent shows the conventionality of using a binder with a pigment and metallic flakes, as herein claimed. Note column 9 (lines 6 et seq.) for the use of a polymer binder, column 10 (lines 47-64) for the use of colorants and column 12 (lines 4-5 and 40-55) for the inclusion of super absorbent particles and metallic flakes. Further, note column 13 (lines 36-59) for the use of graft copolymer super absorbents.

The references to Girg et al, Brüggemann et al, Suskind et al and Young, Sr. et al all teach the conventionality of producing granular superabsorbent compositions that may include a gum, including the claimed guar, gelatin and a binder, as herein claimed. The references also variously show the inclusion of colorants, "glitter" and preservative as conventional for addition to superabsorbent polymer particulates.

The reference to Cordova (US 5,990,205) teaches the conventionality of using a gum, including guar, gelatin, a binder, a colorant, reflective metal particles and a preservative in compositions similar to that recited and claimed. Note column 2 (lines 17-46) for the use of polymer binders, as recited in claim 3, and including those composed of guar gum and gelatin. The employment of a colorant is shown at column 5 (lines 12 et seq.). The preservative is employed at column (lines 40-47).

The reference to Gebhard et al (USPN 5,612,397) teaches the particular binder, that being a copolymer of vinyl pyrrolidone and vinyl acetate, at column 2 (lines 37-59), which are propitious for binding glitter, as taught at column 1. The reference shows the conventional use of preservatives at column 7 (lines 12-20).

The reference to Levy (USPN 5,698,210) teaches the manufacture of a composite that may include a super absorbent polymer, a natural gum, gelatin and a binder. Note column 10 (line 51) to column 11 (line 32) which also teaches the inclusion of a dye, as recited in claim 4. The composition may include a preservative at column 8 (lines 44-63).

The patent to Bowles teaches the conventionality of using a gum and gelatin, as binders for dyes and glitter materials. Note column 7 (lines 16-26) for the binder, gum,

Art Unit: 1711

gelatin, dye and glitter components. The patent clearly includes other additives, which at column 5 (lines 17-24) include thixotropic agents, fillers, flow control agents, etc. which would suggest the inclusion of other absorbents, including super absorbents.

The several components, thus, have conventional and known uses to those having an ordinary skill in the art as regards the production of biodegradable compositions, as disclosed and recited herein. To include the particular binder as claimed in the super absorbents of Girg et al, Brüggemann et al, Suskind et al or Young, Sr. et al, for its art-recognized function would have been prima facie obvious to an artisan of ordinary skill. Further, since these constituents would not be found in any one reference, interpolation of the exact weight percentages for each separate compound need not be shown by any of the several references included in the rejection. The various components are shown by the references to be known in the production of composites and would be used in accordance with the desired characteristics of the final composition as well as cost, availability and other factors of manufacturing and handling. Manipulation of the various components as to inclusion parameters, particle size or distribution, would have been obvious modifications to an artisan in view of these considerations. As such, the instant claims are deemed to be obvious over the teachings of the references. No unexpected results have been shown on the record relating to any particular component or inclusion of any components.

Response to Arguments

Applicant's arguments filed 19 June 2006 have been fully considered but they are not persuasive.

Art Unit: 1711

With regard to the rejection of claims 1-9, 11-19 and 21-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,503,582, since the scope of the claims, as originally filed has changed, the obviousness-type double patenting rejection is being maintained. A timely filed Terminal Disclaimer is necessary to overcome the rejection. The scope of the claims has changed sufficiently from the claims as originally filed as to read on compositions that are different from that recited and claimed in the parent application.

With regard to the rejection of claims 1-9, 11-19 and 21-25 under 35 U.S.C. 103(a) as being unpatentable over Cordova or Bowles, taken with Levy or Young, Sr. et al and in further view of Gebhard et al and Hughes et al, that rejection has been withdrawn.

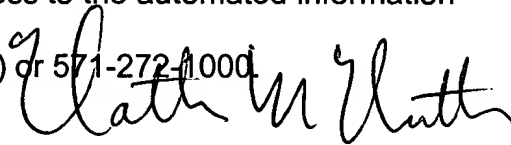
The prior art references show the conventionality of the constituents employed in their art-recognized capacities. A binder for metallic flakes would act as a binder for metallic flakes regardless of what other constituents may be added. Likewise, a preservative taught for use in a guar, gelatin or other natural resin would still behave, and would be fully expected to do so, as a preservative. Applicants ignore the fact that the claims are drawn only to a composition, and not a product with use.

Due to the new ground of rejection this action is not being made FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

26 July 2006